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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,094	08/08/2001	Jung-Wan Ko	1293.1059-CIPD3	3341
49455	7590	01/04/2006	EXAMINER	
STEIN, MCEWEN & BUI, LLP 1400 EYE STREET, NW SUITE 300 WASHINGTON, DC 20005			SHIBRU, HELEN	
			ART UNIT	PAPER NUMBER
			2616	

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/924,094

Applicant(s)

KO ET AL.

Examiner

HELEN SHIBRU

Art Unit

2616

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/26/99, 5/22/03, 04/03/02, 05/09/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-28 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 6, 810, 201. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons set forth below.

The subject matter of claim 1 can be found in patent claim 1, 6, and 9. Patent claim 1 recites a playback apparatus to perform a playback operation on the storage medium which includes audio data, catalog information related to the audio data, and catalog playback information connecting the audio data and the catalog information to each other during playback, the playback apparatus comprising:

a video decoder which decodes from another region the catalog information and additional information to generate a restored image (patent claim 6 recites the playback apparatus of claim 1, wherein the restored image is a still picture for background display, and the

additional information is a sub-picture for transferring characters (caption of the present application claim 1));

an audio decoder which decodes the audio data from an audio region to generate restored audio signals; and

a controller which controls playback of the catalog information reproduced from the another region corresponding to a selection of a user (navigation information of the present application) and the catalog playback information reproduced from the audio region,

wherein:

the storage medium comprises:

the audio region which includes the catalog playback information and an audio title set (ATS) in which is stored the audio data, and

the another region which is other than the audio region and which includes the catalog information and the additional information, the another region further comprising a catalog management (CMG) region having management information on the catalog information, and a catalog title set (CTS) having the catalog information (the catalog information is stored in different region other than the audio region).

Patent claim 9 recites a playback apparatus to perform a playback operation on the storage medium in which audio data, catalog information related to the audio data, and catalog playback information connecting the audio data and the catalog information to each other during playback are recorded, the playback apparatus comprising:

A controller to control the decoding unit so as to simultaneously decode the audio data to be played back and the catalog information corresponding to the audio data to be played back in accordance with the catalog information.

The subject matter of claim 2 can be found in patent claim 10.

The subject matter of claim 3 can be found in patent claims 1, 9, and 11.

The subject matter of claim 4 can be found in patent claim 1.

The subject matter of claim 5 can be found in patent claim 3.

The subject matter of claim 6 can be found in patent claim 4.

The subject matter of claim 7 can be found in patent claim 6.

The subject matter of claim 8 can be found in patent claim 7.

The subject matter of claim 9 can be found in claim 8.

The subject matter of claim 10 can be found in patent claims 1, 6, and 28.

The subject matter of claim 11 can be found in patent claim 29.

The subject matter of claim 12 can be found in patent claims 1, 6, and 32.

The subject matter of claim 13 can be found in patent claim 33.

The subject matter of claim 14 can be found in patent claims 1, 6, 7, and 32.

The subject matter of claim 15 can be found in patent claim 1.

The subject matter of claim 16 can be found in patent claims 12 and 15.

The subject matter of claim 17 can be found in patent claims 12, 13 and 15.

The subject matter of claim 18 can be found in patent claim 14.

The subject matter of claim 19 can be found in patent claim 15.

The subject matter of claim 20 can be found in patent claim 16.

The subject matter of claim 21 can be found in patent claim 17.

The subject matter of claim 22 can be found in patent claim 18.

The subject matter of claim 23 can be found in patent claims 19 and 23.

The subject matter of claim 24 can be found in patent claim 20.

The subject matter of claim 25 can be found in patent claim 24.

The subject matter of claim 26 can be found in patent claim 26.

The subject matter of claims 27-28 can be found in patent claims 1, 6 and 9.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES J. GROODY can be reached on (571) 272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/924,094
Art Unit: 2616

Page 6

Helen Shibu
November 29, 2005

Robert Chale
NOT CHECKED
11/29/2005